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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,678	05/04/2006	Kazuki Noda	59018US007	4637
32692 7590 09/19/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER HENRY, CALEB E				
ART UNIT 2894		PAPER NUMBER		
NOTIFICATION DATE 09/19/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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LegalDocketing@mmm.com

## Office Action Summary

**Application No.**

10/595,678

**Applicant(s)**

NODA, KAZUKI

**Examiner**

CALEB HENRY

**Art Unit**

2894

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 11/06/2006, 09/11/2007, 09/20/2007, 12/19/2007, 07/21/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 11/06/2006, 09/11/2007, 09/20/2007, 12/19/2007, 07/21/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Oka (US 6551906 B2).

Regarding claim 1, Oka teaches a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65), comprising (Figure 1B):

joining the circuit side (front surface [surface at which semiconductor elements are found], col. 2, lines 35-39) of said semiconductor wafer (wafer, 1) to a polymeric film material (tape substrate, 21) via a fluid surface protecting layer (adhesive, 22) which hardens upon radiation exposure (UV light) and hardening said surface protecting layer (Oka, col. 3, lines 35-45).

UV-curing resin in the protective tape would necessitate the use of radiation exposure (UV light) to harden. Also, UV curing resin would have to be fluid in order to be placed onto the circuit side of the wafer.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka (US 6551906 B2) in view of Morita et al. (5516858) referred herein as Morita.

Regarding claim 2, Oka teaches a semiconductor surface protecting method whereby the circuit side (front surface) of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65), comprising:

providing a surface protecting sheet (protective tape, 2) comprising a polymeric film material (tape substrate, 21) on which is a surface protecting layer (adhesive, 22) which becomes fluid upon heating and hardens upon exposure to radiation (UV light),

heating said surface protecting sheet to make the surface protecting layer effectively fluid

placing the circuit side (front surface) of said semiconductor wafer (wafer, 1) in contact with the fluidized surface protecting layer, and

hardening said surface protecting layer (Oka, col. 3, lines 35-45).

One with common knowledge in the art would know that the use of UV-curing resin in the protective tape would necessitate the use of radiation exposure (UV light). Also, one with common knowledge in the art would know that UV curing resin would have to be fluid in order to be placed onto the wafer and this is generally done via heating.

Oka does not teach a surface protecting sheet having a polymeric film material which is solid at room temperature.

Morita teaches a curable resin, used for protective coatings, with a main component (component A) which can be a UV-curing resin which may be a liquid or a solid at room temperature (Morita, col. 3, lines 51-57).

The addition of such a UV curing resin in Oka, which also utilizes a UV curing resin, would allow for greater versatility, since it can be in either a liquid or solid state at room temperature (Morita, col. 3, lines 56-57).

Also, if in a solid state, then this would necessitate the need to, first heat, and then apply to a semiconductor surface since this is the manner in which UV curing resins are applied.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Morita to the teachings of Oka since it would add flexibility to the fabrication process.

Regarding claim 3, Oka teaches a surface protecting sheet for protection of the circuit side of a semiconductor wafer during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65), the surface protecting sheet (protective tape, 2) comprising a polymeric film material (tape substrate, 21) on which is formed a surface protecting layer (adhesive, 22) which becomes fluid upon heating and hardens upon exposure to radiation (UV light).

Oka does not teach a surface protecting sheet having a polymeric film material which is solid at room temperature.

Morita teaches a curable resin, used for protective coatings, with a main component (component A) which can be a UV-curing resin which may be a liquid or a solid at room temperature (Morita, col. 3, lines 51-57).

The addition of such a UV curing resin in Oka, which also utilizes a UV curing resin, would allow for greater versatility, since it can be in either a liquid or solid state at room temperature.

Also, if in a solid state, then this would necessitate the need to, first heat, and then apply to a semiconductor surface since this is the manner in which UV curing resins are applied.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Morita to the teachings of Oka since it would add flexibility to the fabrication process.

7. Claims 4, 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka (US 6551906 B2) in view of Morita et al. (5516858) referred herein as Morita, in further view of Hosomi et al. (5726219), referred herein as Hosomi.

Regarding claim 4, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach a surface protecting sheet according to claim 3, wherein, before hardening of the surface protective layer, the protective layer has an elastic shear loss modulus ( $G''$ ) less than its elastic shear storage modulus ( $G'$ ) at room temperature (20-25°C) and an elastic shear loss modulus ( $G''$ ) greater than its elastic shear storage modulus ( $G'$ ) at 30-100°C, as measured with a viscoelasticity measuring apparatus at a frequency of 10 Hz, a deformation of 0.04% and a temperature ramp rate of 3 °C/min., and the surface protective layer after hardening has an elastic tensile storage modulus ( $E'$ ) at 50°C greater than  $5 \times 10^7$  Pa as measured

with a viscoelasticity measuring apparatus at a frequency of 1 Hz, a deformation of 0.04% and a temperature-ramp rate of 5°C/min.

Hosomi teaches a resin which contains the components necessary to form phenol-novolac epoxy (meth)acrylate resin (Hosomi, col. 2, lines 25 -50, (b)). Since phenol-novolac epoxy (meth)acrylate resin is one of the main materials that can be utilized as the in the surface protecting layer, it must have the characteristics laid out in claim 4.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Hosomi to the teachings of the Oka/Morita combination because phenol-novolac epoxy (meth)acrylate resin offers heat resistance at temperatures as high as 260 degrees Celsius.

Regarding claim 5, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach a surface protecting sheet according to claim 3, wherein the surface protecting layer contains at least one type of a free-radical polymerizable compound having two or more ethylenically unsaturated moieties in the molecule, the free-radical polymerizable compound being:

(3) the following resins having a molecular weight of 1000 or greater which are

solid at room temperature (20-25°C): phenol-novolac epoxy (meth)acrylate resins.

Hosomi teaches a resin which contains the components necessary to form phenol-novolac epoxy (meth)acrylate resin (Hosomi, col. 2, lines 25 -50, (b)).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Hosomi to the teachings of the Oka/Morita combination because phenol-novolac epoxy (meth)acrylate resin offers heat resistance at temperatures as high as 260 degrees Celsius.

Regarding claim 6, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach the use of a free-radical polymerization initiator.

Hosomi teaches the use of a free-radical polymerization initiator (photopolymerization initiator) (Hosomi, col. 2, lines 55-65, (e)).

Free-radical polymerization initiators are needed in UV curing resin in order to initiate polymerization reaction.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Hosomi to the teachings of the Oka/Morita

combination because UV curing resins generally need a free-radical polymerization initiator in order for the UV light to have its intended effect.

Regarding claim 9, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach a surface protecting sheet according to claim 3, wherein the surface protecting layer contains at least one type of a free-radical polymerizable compound having two or more ethylenically unsaturated moieties in the molecule, the free-radical polymerizable compound being:

(3) the following resins having a molecular weight of 1000 or greater which are solid at room temperature (20-25°C): phenol-novolac epoxy (meth)acrylate resins.

Hosomi teaches a resin which contains the components necessary to form phenol-novolac epoxy (meth)acrylate resin (Hosomi, col. 2, lines 25 -50, (b)).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Hosomi to the teachings of the Oka/Morita combination because phenol-novolac epoxy (meth)acrylate resin offers heat resistance at temperatures as high as 260 degrees Celsius.

Regarding claim 10, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach the use of a free-radical polymerization initiator.

Hosomi teaches the use of a free-radical polymerization initiator (photopolymerization initiator) (Hosomi, col. 2, lines 55-65, (e)).

Free-radical polymerization initiators are needed in UV curing resin in order to initiate polymerization reaction.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Hosomi to the teachings of the Oka/Morita combination because UV curing resins generally need a free-radical polymerization initiator in order for the UV light to have its intended effect.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka (US 6551906 B2) in view of Morita et al. (5516858) referred herein as Morita, in further view of Komiyama et al. (5118567), referred herein as Komiyama.

Regarding claim 7, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach a surface protecting sheet according to claim 3 wherein the surface protecting layer contains at least one cationically polymerizable compound having two or more cationically polymerizable groups in the molecule, the cationically polymerizable compound being:

(2) phenol-novolac epoxy resins of molecular weight 1000 or greater which are solid at room temperature.

Komiyama teaches the use of an adhesive tape which is composed of phenol-novolac epoxy resin (Komiyama, col. 3, lines 57-67). This adhesive tape has adhesive/releasing properties which are well balanced, which initially was a problem in prior art (Komiyama, col. 1, lines 30-36).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Komiyama to the teachings of the Oka/Morita combination because it offers a balance between adhesive and releasing properties.

Regarding claim 8, Oka, in view of Morita, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach the use of a free-radical polymerization initiator.

Komiyama teaches the use of a cationic polymerization initiator (photopolymerization initiator) (Komiyama, col. 2, lines 1-12).

Cationic polymerization initiators are needed in UV curing resin in order to initiate polymerization reaction.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Komiyama to the teachings of the Oka/Morita combination because UV curing resins generally need a free-radical polymerization initiator in order for the UV light to have its intended effect.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka (US 6551906 B2) in view of Morita et al. (5516858) referred herein as Morita, in further view of Hosomi et al. (5726219), referred herein as Hosomi, in further view of Komiyama et al. (5118567), referred herein as Komiyama.

Regarding claim 11, Oka, in view of Morita, in further view of Hosomi, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach a surface protecting sheet according to claim 3 wherein the surface protecting layer contains at least one cationically polymerizable compound having two or more cationically polymerizable groups in the molecule, the cationically polymerizable compound being:

(2) phenol-novolac epoxy resins of molecular weight 1000 or greater which are solid at room temperature.

Komiyama teaches the use of an adhesive tape which is composed of phenol-novolac epoxy resin (Komiyama, col. 3, lines 57-67). This adhesive tape has adhesive/releasing properties which are well balanced, which initially was a problem in prior art (Komiyama, col. 1, lines 30-36).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Komiyama to the teachings of the Oka/Morita/Hosomi combination because it offers a balance between adhesive and releasing properties.

Regarding claim 12, Oka, in view of Morita, in further view of Hosomi, teach a semiconductor surface protecting method whereby the circuit side of a semiconductor wafer is protected during the step of back side grinding of the wafer (Oka, col. 2, lines 55-65).

Oka, in view of Morita, does not teach the use of a free-radical polymerization initiator.

Komiyama teaches the use of a cationic polymerization initiator (photopolymerization initiator) (Komiyama, col. 2, lines 1-12).

Cationic polymerization initiators are needed in UV curing resin in order to initiate polymerization reaction.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Komiyama to the teachings of the Oka/Morita/Hosomi combination because UV curing resins generally need a free-radical polymerization initiator in order for the UV light to have its intended effect.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CALEB HENRY whose telephone number is (571)270-5370. The examiner can normally be reached on Monday-Thursday, 7:30 AM- 5:30 PM, ALT. Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly D Nguyen can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caleb Henry/  
Examiner, Art Unit 2894

/Kimberly D Nguyen/  
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